Docket No.: 13CN-126552
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Anthony AQUILA, et al.

Application No.: 09/825,604 Confirmation No.: 3275

Filed: April 3, 2001 Art Unit: 3686

For: SYSTEM AND METHOD OF ADMINISTERING TRACKING AND MANAGING OF CLAIMS PROCESSING

Examiner: Amber L. ALTSCHUL

REPLY BRIEF UNDER 37 C.F.R. § 41.41

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Commissioner for Patents
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INTRODUCTORY COMMENTS

This paper is in response to the Examiner's Answer, mailed December 12, 2008, time for response to which was set to expire February 12, 2009. This Reply Brief is part of an appeal from the Examiner's Final Office Action mailed October 9, 2007 finally rejecting claims 25, 73-82, and 84-93 in the above-identified patent application.

I. Status of Claims

Claims 25, 73-78, 80-82, 84-89, and 91-93 are pending in the application. Claims 25, 73, and 84 are independent. Claim 1-24, 26-72, 79, 83, and 90 were cancelled. Claims 25, 73-78, 80-82, 84-89, and 91-93 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,810,383 to Loveland ("Loveland"). Claims 25, 73-78, and 80-82 were amended on October 20, 2008, subsequent to the filing of the Appeal brief.

The rejection of claims 25, 73-78, 80-82, 84-89, and 91-93 is appealed.

II. Status of Amendments

The amendment after final rejection filed on October 20, 2008 has been entered.

III. Grounds of Rejection to be Reviewed on Appeal

The ground of rejection to be reviewed on appeal is whether newly amended claims 25, 73-78, 80-82; and previously presented claims 84-89 and 91-93 are anticipated by U.S. Patent No. 6,810,383 to Loveland ("Loveland") under 35 U.S.C. § 102(e).

IV. Argument

The Appellant reiterates and reaffirms the Arguments made in the Appeal Brief. Additionally, the Appellant addresses each of the Examiner's positions to Arguments A-F in the paragraphs below.

Argument (A)

The Examiner's Answer, mailed December 12, 2009, states that the "Examiner interprets the final result of project parameters being defined and appropriate rules applied to be a form of overall score of the claim." (Examiner's Answer, p. 8). The Appellant respectfully disagrees.

The project parameters and applied rules in Loveland do not teach or suggest assigning a score to data elements. Rather, in Loveland, project parameters are applied to rules that cause specific actions to take place based on specific situations. Examples from Loveland include creating a structure file when one does not exist, regulating the use of floor plans or structural features, including photos, etc. (See col. 14, ln. 49 to col. 15, ln. 5). These are specific actions taken based on specific rules, rather than a score based on data elements.

Additionally, these actions build a claim file rather than assign a score. For example, the rules in Loveland can be system rules or assignor rules. An example system rule may cause the system of Loveland to access a structure file for structure information. This structure information is used to build the claim file, not to generate a score. Similarly, the assignor rules establish some aspect of the claim or regulate information retrieval from a structure file. This claim information or structure file information is also used to build the claim file, not to generate a score. (See col. 14, ln. 49 to col. 15, ln. 5). Accordingly, the "final result" is a complete claim file, rather than a score. (See col. 15, lns. 58-60).

Argument (B)

The Examiner's Answer, mailed December 12, 2009 states that the "Examiner interprets the final result of project parameters being defined and appropriate rules applied to be a form of overall score of the claim." (Examiner's Answer, p. 8). The Appellant respectfully disagrees.

As discussed above, Loveland does not teach or suggest scoring. In Loveland, project parameters are applied to a set of rules that cause specific actions to take place based on a specific situation. As discussed above, the various actions build a claim file, which is not an overall score, it is a file of information regarding the claim. Accordingly, because Loveland does

not teach scoring, it cannot teach an overall score. Moreover, because Loveland does not teach a score, it cannot teach an overall score based on a combination of multiple scores.

Argument (C)

The Examiner's Answer, mailed December 12, 2009 states that "it is readily apparent that Loveland suggests determining a type of assignee based on the overall score and class of the insurance claim, and also weighting class more highly than the score." (Examiner's Answer, p. 8). The Appellant respectfully disagrees. As discussed above, because Loveland does not teach scoring or an overall score, it cannot teach or suggest determining a type of assignee based on the overall score and class of the insurance claim or weighting class more highly than a score.

The Examiner "interprets the type or class of claim is weighted more highly because only those service providers who are qualified to perform the project are matched based on the assignment process." (Examiner's Answer, pp. 8-9). This is not weighting. As the Examiner admits, Loveland allows only qualified providers to be assigned claims. This is a gating or a minimum threshold function with a hard cutoff. This is not a "weighting" function. Moreover, Loveland does not rank class more highly; rather, it only assigns claims to service providers who are qualified to perform the project. In other words, the assignment process does not weight class, rather it determines which service providers can work on which claims. Those claims are then assigned in turn rather than based on weighting of class or score. (See col. 15, lns. 58-60).

Moreover, in Loveland it is the service providers that are ranked or weighted, not the claims. (See col. 15, ln. 38 – col. 16, ln. 5). The ranking of the service providers may affect the assignment of the claim, but no claim weighting occurs.

Arguments (D, E, and F):

The Examiner's Answer, mailed December 12, 2009 asserts that "Appellant has simply cited a portion of the reference and concluded that, based on the citation, the reference does not disclose the claimed invention. Appellant has provided no reason **why** the cited reference does not disclose the claimed feature." (Examiner's Answer, p. 9, emphasis in original). The Appellant respectfully disagrees.

In the Appeal Brief, the Appellant stated that "[c]laims 74-76, 78, and 80-82 depend from and add additional limitations to claim 73" and that the dependent claims are patentable over Loveland for at least the same reasons discussed with respect to claim 73. The Appellant

also stated that "[c]laims 85-87, 89, and 91-93 depend from claim 84" and that the dependent claims are patentable over Loveland for at least the same reasons discussed with respect to claim . . . 84. Section 112 provides that "[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." 35 U.S.C. § 112. Accordingly, any claims that depend from an allowable base claim are allowable because they incorporate all the limitations of the claim to which they refer. Stating that claims 74-76, 78, and 80-82 are patentable over Loveland for at least the same reasons discussed with respect to claim 73 and that claims 85-87, 89, and 91-93 are patentable over Loveland for at least the same reasons discussed with respect to claim . . . 84 are valid reasons "**why** the cited reference does not disclose the claimed feature."

Claims 81 and 92 are also patentable over Loveland because nothing in Loveland teaches or suggests "each data element include[ing] an element score, and wherein the claim score is based on the element scores of the data elements." As discussed above, Loveland does not generate a score; rather it takes an action to generate a claim file. Accordingly, Loveland cannot teach element scores or a claim score based on element scores. Additionally, even assuming, *arguendo*, Loveland does teach a score, there is nothing whatsoever in Loveland that teaches individual element scores, let alone an overall score based on the multiple element scores.

Claims 77 and 88 are allowable for the additional reason that Loveland fails to teach or suggest "determining, based on the claim score, a priority of the insurance claim." In rejecting claim 77, the Examiner stated that claim 77 "contain[s] substantially similar limitations to those already addressed in claim 25 and, as such, are rejected for similar reasons given above," but fails to cite to anywhere in Loveland where these limitations of claims 77 and 78 could be found.

As discussed above, with respect to Argument (A), Loveland does not teach or suggest scoring. Accordingly, it cannot teach or suggest "determining, based on the claim score, a priority of the insurance claim." Moreover, there is no teaching in Loveland whatsoever of prioritizing a claim based on score. In Loveland claims are simply assigned, they are not prioritized. (See col. 15, lns. 58-60). On the contrary, as discussed above, in Loveland, it is the service providers that are ranked, not the claims. For at least these reasons, claims 77 and 88 are allowable.

CONCLUSION

The subject matter of claims 25, 73-78, 80-82, 84-89, and 91-93 is patentable over the cited art because the Examiner has failed to show that each and every feature of the claimed embodiments is taught in the cited reference. Therefore, Appellants respectfully request that the Board reverse the Examiner's final rejection of these claims under 35 U.S.C. § 102(e) and remand this application for issue.

Dated: February 12, 2009

Respectfully submitted,

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